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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,854	01/28/2000	Charles Eric Hunter	**OO-0002	2737

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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01/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 11, 2003 has been entered.

Election/Restriction

2. This application contains claims 1-41 and 52-97 drawn to inventions nonelected with traverse in the reply filed March 15, 2002. A complete reply to the final rejection must include cancellation of the nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 42, 43, 45, and 47-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulhof et al. (US 5,557,541).

Schulhof et al. disclose a system for recording music, comprising: a plurality of user stations at dispersed customer locations, the user stations including means for receiving and recording transmitted music selections; a control system blanket transmitting music selections to the user stations; and, a communications link between the user stations and the control system to verify to the control system when selected music selections have been recorded; wherein the control system includes means for billing the customer locations for music selections that are recorded.

Regarding claim 43, in the system of Schulhof et al., each of the user stations includes a graphical user interface to help customers select music selections for recording.

Regarding claim 45, in the system of Schulhof et al., each of the user stations includes a storage medium for initially storing the transmitted music selections.

Regarding claim 47, in the system of Schulhof et al., when the customer decides to purchase a music selection, the graphical user interface prompts the customer to insert a recording medium into the user station.

Regarding claim 48, in the system of Schulhof et al., the customer locations are customer households.

Regarding claim 49, in the system of Schulhof et al., each user station includes a compact disc writer for recording the selected music selections.

Regarding claim 50, in the system of Schulhof et al., the control system includes a database for storing a plurality of addresses, each of said locations being associated with one of said addresses.

Regarding claim 51, in the system of Schulhof et al., the control system includes means to update music pricing at any time.

5. Claims 42-47 and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (US 5,418,713).

Allen discloses a system for recording music, comprising: a plurality of user stations at dispersed customer locations, the user stations including means for receiving and recording transmitted music selections; a control system blanket transmitting music selections to the user stations; and, a communications link between the user stations and the control system to verify to the control system when selected music selections have been recorded; wherein the control system includes means for billing the customer locations for music selections that are recorded.

Regarding claim 43, in the system of Allen, each of the user stations includes a graphical user interface to help customers select music selections for recording.

Regarding claim 44, in the system of Allen, the graphical user interface identifies music selections by artist, title, and category.

Regarding claim 45, in the system of Allen, each of the user stations includes a storage medium for initially storing the transmitted music selections.

Regarding claim 46, in the system of Allen, each of the user stations includes means for the customer to preview the stored music selections at no charge, and thereafter to decide whether to purchase a permanent copy of the previewed music selections.

Regarding claim 47, in the system of Allen, when the customer decides to purchase a music selection, the graphical user interface prompts the customer to insert a recording medium into the user station.

Regarding claim 49, in the system of Allen, each user station includes a compact disc writer for recording the selected music selections.

Regarding claim 50, in the system of Allen, the control system includes a database for storing a plurality of addresses, each of said locations being associated with one of said addresses.

Regarding claim 51, in the system of Allen, the control system includes means to update music pricing at any time.

Response to Arguments

6. Applicant's arguments filed November 11, 2003 have been fully considered but they are not deemed persuasive.

7. Regarding the argument that the references applied in the prior art rejections fail to use the same names for certain elements as the names used by applicant (i.e., "blanket transmitting"), the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Additionally, note that, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

8. To the extent that applicant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to “Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.” Hand delivered replies should be delivered to the “Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314.”

GJOC

January 17, 2008

/Gerald J. O’Connor/
Primary Examiner
Group Art Unit 3627

Office Action Summary	Application No. 09/493,854	Applicant(s) Hunter et al.	
	Examiner O'Connor	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 11, 2003 (RCE).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
 4a) Of the above claim(s) 1-41 and 52-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 24, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20021218 and 20071017</u> | 6) <input type="checkbox"/> Other: _____ |